

REMARKS

This is a response to the Non-Final Office Action of October 5, 2005 in which claims 1-26 were rejected.

In Section 2, the Examiner rejected claims 1-5, 9-13, 15-20 and 25 under 35 U.S.C. 102(e) as being anticipated by Falcon et al., U.S. Patent Pub. No. 2005/0153749. The Applicant believes that the Examiner's statements are not accurate and need further clarification. The Examiner's arguments are analysed based on MPEP guidelines which are stated in the MPEP Paragraph 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. "The identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. ...

Regarding independent claim 1, contrary to the Examiner's statement that all elements and claim limitations are disclosed by Falcon et al., it is evident to the Applicant that Falcon et al. do not disclose "at least one switch" recited in claim 1 of the present

invention, i.e., the connectors 154 and 156 described by Falcon et al. in paragraph 032 are not switches.

Moreover, Falcon et al. do not disclose the following step of claim 1: "...communicating said reversal of the state of said at least one switch to said communication device, wherein said reversal is interpreted by the communication device as said at least one predetermined command by the user." There is no mentioning of "state reversal" or "predetermined command" by Falcon et al.

Therefore, in light of the above, the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Falcon et al., is unsupported by the art and should be withdrawn per MPEP Paragraph 2131 quoted above.

Independent claim 15 of the present invention is of the same scope as claim 1. Therefore, the arguments regarding claim 1 presented above are applied to claim 15 as well and the rejection of claim 15 under 35 U.S.C. 102(e) as being anticipated by Falcon et al., is unsupported by the art and should also be withdrawn per MPEP Paragraph 2131 quoted above.

The Examiner does not present any arguments regarding rejection of dependent claims 2-5, 9-13, 16-20 and 25 under 35 U.S.C. 102(e) as being anticipated by Falcon et al., i.e., the Examiner does not show at all or present any argumentation that limitations of claims 2-5, 9-13, 16-20 and 25 are supported by Falcon et al., therefore rejection of claims 2-5, 9-13, 16-20 and 25 under 35 U.S.C. 102(e) should be withdrawn per MPEP Paragraph 2131 quoted above.

Even if (for the sake of argument only) the Examiner would present such argumentation to support rejection of claims 2-5, 9-13, 16-20 and 25 under 35 U.S.C. 102(e), claim 2-5, 9-13, 16-20 and 25 are dependent claims (directly or indirectly) of independent claims 1, or 15, respectively. Since independent claims 1, and 15 are not anticipated by Falcon et al. under 35 USC Section 102(e), as shown above, dependent claims 2-5, 9-13, 16-20 and 25 referred to corresponding novel independent claims 1 and 15 are also novel, and, therefore, they are not anticipated by Falcon et al. under 35 USC 102(e).

In Section 4, the Examiner rejected claims 6-9, 14, 21-24 and 26 under 35 U.S. 103(a) as being unpatentable over Falcon.

The applicant believes that the Examiner's statements are not accurate and need further clarification.

First, regarding claims 6-9, 14, 21-24 and 26, these are dependent claims (directly or indirectly) of independent claims 1 and 15. Independent claims 1 and 15 are not unpatentable over Falcon et al., as stated above. Since each of the dependent claims 6-9, 14, 21-24 and 26 narrows the scope of the novel and non-obvious independent claims 1 or 15, non-obviousness of claims 1 and 15 will compel non-obviousness of claims 6-9, 14, 21-24 and 26.

Even if (for the sake of argument only) the Examiner is correct in rejecting claims 1 and 15 as being

anticipated by Falcon et al. under 35 USC 102(e) (which is not the case as stated above), the 35 U.S.C.103(a) rejection of claims 6-9, 14, 21-24 and 26 is not substantiated by the Examiner. In that regard, the 35 U.S.C.103(a) rejection of claim 16-9, 14, 21-24 and 26 is analyzed using MPEP guidelines which are stated in the MPEP Paragraph 2143 as follows:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

First, the Examiner does not show that Falcon et al. teach or suggest all the limitations of claims 6-9, 14, 21-24 and 26 as required by the MPEP Paragraph 2143 to establish a *prima facie* case of obviousness as stated above.

Second, even if only for the sake of argument we assume that Falco et al. teach or suggest all the limitations of claims 6-9, 14, 21-24 and 26, the Examiner does not show that there is suggested desirability or

motivation, expressed explicitly, implicitly or even hinted at by Falcon et al. or generally available to one of ordinary skill in the art to modify the reference of Falcon et al. to arrive at the subject matter of claims 6-9, 14, 21-24 and 26 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law) at the time of the invention. For example, the Examiner does not find or provide motivation existed at the time of the invention why a person skilled in the art would use a tilting motion or mount the cradle on car dashboard or on a bicycle handlebars to arrive at the subject matter of the corresponding dependent claims (by modifying teachings of independent claims 1 and 15). The Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a

teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

In other words, the Examiner failed to show a *prima facie* case of obviousness because he does not show any basis even remotely present in the art at the time of the invention for modifying reference Falcon et al. (see MPEP paragraphs 2142, 2143 quoted above, and the case law) to arrive at the subject matter of claims 6-9, 14, 21-24 and 26.

Third, the Examiner does not show that Falcon et al. provide teaching or suggestion for the reasonable expectation of success by modifying teaching of Falcon et al. to arrive at the subject matter of claims 6-9, 14, 21-24 and 26, as required by the MPEP paragraph 2143, quoted above to establish a *prima facie* case of obviousness.

In light of the above considerations, the Examiner does not present arguments regarding rejecting dependent claims 6-9, 14, 21-24 and 26 under 35 U.S.C. 102(e) as being obvious over Falcon et al. In other words, the Examiner failed to show a *prima facie* case of obviousness, therefore rejection of claims 6-9, 14, 21-24 and 26, under 35 U.S.C. 103(a) should be withdrawn per MPEP Paragraph 2143, 2142 and the case law quoted above.

Docket No. 944-003.211
Serial No. 10/781,044

The objections and rejections of the Office Action of October 5, 2005, having been obviated and shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-26 to issue is solicited.

Respectfully submitted,



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Date: November 10, 2005

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